

Appl. No. 10/576,918
Amdt. Dated: August 14, 2008
Reply to Office action of May 21, 2008

REMARKS/ARGUMENTS

Claims 1-17 are currently pending. Claims 8-17 have been withdrawn from consideration by the Examiner as a result of a restriction requirement.

Rejection under 35 U.S.C. § 103(a)

Claims 1-7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kihlberg et al (WO 02/102711 A1) ("Kihlberg") and Rahman et al (Journal of Organic Chemistry 2003, 68, 3558-3562) ("Rahman").

In response, Applicants respectfully submit that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). (emphasis added).

On page 3 of the Office Action, the Office states :

It would have been *prima facie* obvious to one skilled in the art at the time the invention was made to modify the process of Kihlberg et al., by including the UV lamp in the system for labeling as taught by Rahman et al., because the latter reference is expressly teaching that in the synthesis of ¹¹C-labeling, use of a YV lamp is old in the art...

For a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. Indeed, M.P.E.P. § 2143.03 states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered

in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants respectfully point out that, unlike the present invention, Rahman teaches the use of a palladium catalyst to promote the labeling reaction. The instant invention, however, describes a different approach – free radical mediated reaction. Therein UV assembly is used to promote reaction wherein UV light cleaves a carbon-iodine bond to generate free radicals. This free radical mediated reaction disclosed in the present invention is not suggested nor disclosed in Rahman or Kihlberg.

Additionally, superficially both reactions and mechanisms look very similar: mix CO, an iodide, and an amine to obtain labeled amide; but reaction mechanisms are different. Please see Figure 1 of both the present invention and Kihlberg. Figure 1 shows a flow chart over the method according to the respective inventions. Please note that right after the use of carbon-isotope monoxide enriched gas-mixture the inventions diverge. Applicants further state that the use of UV light in the present invention allow reactions to run at room temperatures or even lower to suppress undesired processes where the prior references could not account for these issues.

Applicants further point out that both references cited, Rahman and Kihlberg, are assigned to GE Healthcare. If the authors/Inventors knew that such a method of the present invention was obvious they would have claimed this method as well.

Accordingly, the claims of the present invention can not then be merely assumed obvious from the Examiner's subjective view point. Appellants note that "the prior art itself must provide a motivation or reason for the worker in the art, without the benefit of the Applicant's specification, to make necessary changes in the reference device". See, *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438 (PTO Bd. App. 1984).

Furthermore, Applicants respectfully point out here that it is well settled in the law that a reference must be considered not just for what it expressly teaches, but also for what it fairly suggests to one who is unaware of the claimed invention. *In re Baird*, 16 F.3d 380, (Fed. Cir. 1994).

Additionally, the Office fails to articulate what "guidance" is provided to employ UV radiation including the presence of a UV lamp, a concave mirror, and a window in the high pressure reaction chamber facing the concave mirror, when both Kihlberg and Rahman are silent as to this assembly. The Office has not provided any teaching or reason why one of ordinary skill in the art would have used the UV components as claimed in claim 1 in the process and components discussed in Kihlberg. Because the reactions of Kihlberg and Rahman are palladium catalyzed, there would be no reason why one of ordinary skill in the art would modify the assembly of Kihlberg with UV components, since application of UV radiation would generate free radicals (*see* specification, page 24, lines 1-5), a completely different mechanism than the palladium catalyzed reaction (*see* Rahman, page 3559, Scheme 1). Therefore, the rejection of claims 1-7 is deficient and should be withdrawn.

Double Patenting

Claims 1-7 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-7 of copending Application No. 11/268,107 ("the '107 application"). The Office alleges that the claims are not patentably distinct because claims 1-7 of the instant application are "well within the scope of Claim[sic] of the base claim 1 and specifically claim 2-5 of the copending application."

In response, Applicants note that M.P.E.P § 804 recites:

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer.

In the instant case, the present application is a 371 of PCT/IB04/03488 filed on October 25, 2004, which is earlier than the filing date of 11/268,107, filed on November 7, 2005.

Applicants respectfully submit that in view of the above remarks, the obviousness double patenting rejection is the only rejection remaining in this case. Therefore, Applicants respectfully submit that the double patenting rejection should be withdrawn.

CONCLUSION

For all the reasons set forth above, an indication of allowance of all claims is solicited. In the event any outstanding issues remain in the Application, the Examiner is more than welcome to telephone the undersigned counsel to resolve any such issues in the interest of expediency and to further place the application in condition for allowance.

Respectfully submitted,

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